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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,312	07/01/2005	Christoph Deutsch	63668(49338)	8063
21874	7590	06/22/2007		
EDWARDS ANGELL PALMER & DODGE LLP			EXAMINER	
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BOSTON, MA 02205				
			ART UNIT	PAPER NUMBER
			3651	
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			06/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,312

Applicant(s)

DEUTSCH, CHRISTOPH

Examiner

Khoi H. Tran

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

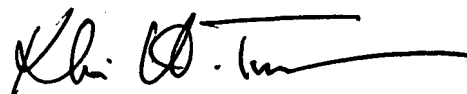
- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/06, 04/06, 03/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____



KHOI H. TRAN
PRIMARY EXAMINER

DETAILED ACTION

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because of improper usage of implied phrases and legal terminologies, i.e. "The invention relates" and "means". Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 34-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claims 34-54, the method claims recite a narrative of what happens in passive terms. It is not clear and distinct as to which method step is actually being performed and claimed. Per USPTO Practice, a process claim should indicate what acts comprise performance of the method. For example, the method should be defined in terms of actively recited steps, such as assembling, allocating, providing, attaching...

In regards to claims 34 and 55, line 3 and 2 respectively, it is not distinct what "EDP" represents. Applicant is required to spell out the entire acronym terminology.

In regards to claims 37, 38, 41, 44, 55, 60, 61, 63, the respective terms "optionally", "may be", "preferably" render the claims indefinite. It is not distinct whether the step(s) or element(s) following said terminologies actually exist with the claimed combination.

In regards to claim 55, line 8 and line 11, "the addressee-specific printed sheet", "printed product", and "medium" lack antecedent bases.

In regards to claim 58, line 3, "the media attachment unit" lacks antecedent basis.

In regards to claims 60 and 62, "an information detection unit" lacks positive identification. It is not distinct whether said unit is actually part of the claimed combination. Positive recitation of the information unit is required.

In regards to claims 61 and 62, "an information transmission unit" lacks positive identification. It is not distinct whether said unit is actually part of the claimed combination. Positive recitation of the information unit is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 34-42, 46-52, 54-61, and 64, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Graushar et al. (U.S. Patent No. 6,694,219).

Graushar et al. '219 disclose a system and method for producing personalized magazines having personalized inserts per claimed invention. The system comprises a

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control system having a database. The system comprises a printed production unit 10 for printing sheets including cover pages, a media production unit for producing customized media, i.e. CDs, and a dispatching unit for preparing the substantially finished printed product for dispatch (Figures 1 and 4). The printed production unit comprises at least one media attachment unit for attachment of the customized media on an inner page of the magazine. The printed production unit comprises a gatherer stitcher having plurality of feeders for assembling printed sheets and the media attachment could be located anywhere along the stream of the feeders (column 5, lines 14-18). Graushar et al. '219 system comprises a scanner 29 for reading identification and/or control markings on the media. The scanner transfers read information to the control system for printing customized address indicia onto respective cover pages and/or the media, before or after the attachment of media to the magazines (column 5, lines 8-12, column 6, lines 15-64).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 38, 46, 47, 50, 53, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar et al. (U.S. Patent No. 6,694,219).

In regards to claims 38, 46, 47, and 50, it is obvious that the pages on Graushar et al. '219 binding and stitching line would have to be assembled in predetermined sequence to provide orderly printed magazines.

In regards to claims 53 and 63, it is obvious that Graushar et al. '219 personalized inserts could be cards. Providing personalized cards to magazines has been known per Graushar et al. "Field of Invention".

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar et al. (U.S. Patent No. 6,694,219) in view of Duke et al. (U.S. Patent no. 6,240,334).

Graushar et al. '219 discloses all elements per claimed invention. However it is silent as to the specifics of comparing the read marking on the personalized media to a predetermined sequence for detection of discrepancies.

Duke et al. '334 teach that scanned personalized insert information is compared to predetermined inserting sequence to ensure proper placement thereof.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have compared Graushar et al. '219 scanned information to a predetermined inserting sequence because it ensures proper placement of the personalized inserts, as taught by Duke et al. '334.

9. Claims 43-45, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar et al. (U.S. Patent No. 6,694,219) in view of Stevens (U.S. Patent No. 5,590,912).

In regards to claims 43-45 and 62, Graushar et al. '219 discloses all elements per claimed invention including a data-reading machine 29 for reading indicia on the personalized media. However, it is silent as to the specifics of using OCR and barcode technologies for the recognition of machine-readable markings.

Stevens '912 discloses a system and method for producing personalized magazines having personalized inserts. Stevens '912 teaches that providing OCR font and barcode to a personalized media is commonly well known.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have used OCR and barcoding technologies with Graushar '219 et al. data-reading machine because they facilitate the commonly well known electronic data recognition means, as taught by Stevens '912.

Conclusion

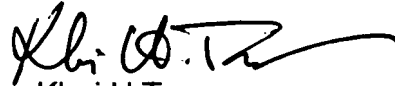
10. Additional references made of record and not relied upon are considered to be of interest to applicant's disclosure: see attached USPTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
06/13/2007